



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/212,833	12/16/1998	DANIEL E. LEWIS	TELNP0163US	7815

7590 03/25/2003

MARK D SARALINO
RENNER OTTO BOISSELLE & SKLAR
19TH FLOOR
1621 EUCLID AVENUE
CLEVELAND, OH 44115

EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
----------	--------------

2635

8

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/212,833

Applicant(s)

LEWIS, DANIEL E.

Examiner

Edwin C. Holloway, III

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1-13-03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Examiner's Response

1. In response to applicant's amendment filed 1-13-03, the examiner has considered the claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle '174 (US 5787174) in combination with Ward (US 6064676) and/or Anders (US 4827395). Tuttle '174 discloses a remote ID system with a passive transponder or tag 4 connected to memory 3 and processor 44 shown in fig. 3. An interrogator shown in fig. 4 interrogates the can read data from using a conventional protocol such as Ethernet. See cols. 6 and 8. The memory is configured during manufacture using suitable methods for storing in the memory a unique serial number as the package is manufactured as are commonly used in making conventional Ethernet LAN transceivers which store a unique device address in col. 3 line 28 - col. 4 line 14, but does not describe wireless writing to the memory through the transponder. Ward discloses an analogous art self powered memory ID tag where a memory 111 includes RF interface 130 to communicate with an RFID tag and serial interface 150 to communicate with an

attached device. An interrogator 19 reads and writes data to the tag when the connected device is not powered. Ethernet addresses can be used. See col. 2 lines 25-65, col. 4 lines 49-56 and col. 7 lines 26-36. Anders discloses an analogous art passive transceiver or transponder which can be attached to an external circuit and it's address programmed by an active transceiver or interrogator. See col. 11 lines 55-61. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Tuttle '174 the writing of information from an interrogator to the memory via the tag because such is shown in Ward in order to allow wireless read and write to a device memory when the device is not operating and/or because Anders discloses this for wireless configuration of the transponder ID. The combination of Tuttle and Ward is suggested by both systems using Ethernet protocols and addresses. If programming of the network address is not clear, then such would have been obvious in view of Tuttle '174 disclosing in col. 4 lines 8-14 that the memory is programmed in the same manner as Ethernet local area transceivers, because Anders includes wireless programming of a transponder memory from an interrogator and because applicant's disclosure admits that it is well known to wirelessly program Ethernet configuration.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle '174 (US 5787174) in combination with Ward (US 6064676) and/or Anders (US 4827395) as applied above and further in view of Thompson. If it is required that the device connected to the transponder or tag include a separate transceiver then such would have been obvious in view of Thompson disclosing an application module 100

in fig. 10 including a transceiver 104 and memory 184 connected to configure a device in fig. 8 including another radio transceiver 90 and processor 280. See cols. 13-16.

Although the application module is disclosed to include a battery, a passive device would have been obvious as provided in Tuttle '174, Ward and/or Anders to avoid the need to replace or recharge the battery.

Response to Arguments

5. Applicant's arguments filed 1-30-03 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The argument that Tuttle's "main circuit 1 does not control operations based on the serial number stored in the ID circuit" is not persuasive because the circuit 1 can provide control such as output an error signal or disable operation in response to invalid ID in col. 4 line 66 - col. 5 line 23. The argument that any interface between the main circuit 1 and the memory is only for the purpose of decrypting and/or validating is not persuasive because the claimed interface merely enables access to the memory, regardless how it is used. Further, the rejection includes a combination with Ward that includes a serial interface 150 with write protect controlled by protect input 161 from external computer or device to protect memory 111 from changes by RF port 113 in col. 3 lines 10-28. A further rejection includes Thompson to show a microprocessor 180,

Art Unit: 2635

memory 184 and transceiver 104 connected by interface 94 to further memory 284, processor 280 and transceiver 90. The argument that the ID circuit 2 of Tuttle is preferably configured during manufacture and thus does not show or suggest a processor for controlling operation of the transceiver based initial configuration information and/or transmitting initial configuration information from a source external to the device to be received by the wireless passive tag is not persuasive because the claims do not preclude use during manufacture and because Ward, Anders, and/or Thompson disclose wirelessly receiving initial configuration information used by a processor to control a transceiver. The argument that Tuttle teaches "installing" the ID number during manufacture rather than transmitting it from an external source is not persuasive because Tuttle discloses write enable input by wafer probe which is an external device. Further, Ward, Anders, and/or Thompson disclose wirelessly receiving initial configuration information from an external device.

The argument that Tuttle teaches the disadvantage of re-writable memory possibly being re-written by a thief is not persuasive because Tuttle also teaches that re-writable memory has the advantage that the contents cannot be detected with a microscope, which is a disadvantage of permanent memory. The argument that the transmission of initial information from an external device would destroy the write enable safeguard of Tuttle is not persuasive because Ward, for example, includes a write protect input having the write enable protection function that can block access from an RF port. This input may obviously be sealed after input of the initial configuration information as a manufacturing step.

The argument that the combination would destroy the anti-theft objectives of Tuttle is not persuasive for the reasons stated above. Ward, for example, includes a write protect input having the write enable protection function that can block access from an RF port. Tuttle enables writing during manufacture, and since manufacturing is not complete until "initial" configuration information is supplied, the wireless input of initial configuration information by Ward, Anders, and/or Thompson would not destroy Tuttle.

The argument that Tuttle is only applicable to "during manufacture" is not persuasive because the claims do not preclude this and because writing "initial" configuration information is considered part of manufacturing as stated above.

The argument that the applied art lacks any teaching that initial configuration information should be wirelessly transmitted and that this would not destroy the anti-theft features of Tuttle is not persuasive because, as stated above, Ward, Anders, and/or Thompson disclose wirelessly receiving initial configuration information such as addresses from an external device and because Ward, for example, includes a write protect input having the write enable protection function that can block access from an RF port

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONTACT INFORMATION

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology center 2600 receptionist whose telephone number is **(703) 305-4700**.

Facsimile submissions may be sent via fax number (703) 872-9314 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30:-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH
3/21/03


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635